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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,459	03/18/2005	Michael Mulligan	915-006.072	4930

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EXAMINER
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LINDSEY, MATTHEW S

ART UNIT	PAPER NUMBER
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05/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**MAILED**

**MAY 04 2009**

**TECHNOLOGY CENTER 2100**

In re Application of:  
Michael Mulligan.  
Application No. **10/528,459**  
Filed: March 18, 2005  
Docket No. 915-006.072  
Title: METHOD, DEVICE AND SYSTEM FOR  
PROVIDING ADDITIONAL INFORMATION  
RELATED TO THE CONTENTS OF A RADIO  
BROADCAST TO TERMINAL DEVICES

**DECISION ON PETITION  
UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed November 28, 2008 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require the Examiner to withdraw the finality of the rejection mailed October 28, 2008.

The Applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the Examiner in relation to the Final Office Action October 28, 2008. In the petition, Applicant's counsel alleged that the finality of the office action was improper in light of the notification from the Legal Examiner of PCT Legal Affairs in the Office of Patent Cooperation Treaty Legal Administration received thereby on October 30, 2008. The notification indicates that the Office of Patent Cooperation Treaty Legal Administration made a determination that the claims 1-23 included as an annex to the Form PCT/IPEA/416 are the claims that should have been examined. Since the Examiner has examined the wrong set of claims, it is requested that the finality of the action of October 28, 2008 be withdrawn and a non-final Office Action be issued examining the correct set of claims 1-23.

This petition is **GRANTED**.

**RELEVANT HISTORY PROSECUTION**

03/18/08      Original claims are filed 1-25  
03/18/08      Preliminary amendment filed claims 1-23  
06/06/08      Non-final action is mailed in response to amendment filed March 18, 2005.

- 08/21/08      Petition for review and processing by PCT legal office. It was requested that the PCT Legal Group confer with the Examination Group and address this situation so that the *objection to the numbering* of the claims is withdrawn and that the Examining group recognize that the claim numbering upon entering the U.S. National Stage was claims 1-23, not claims 1-25.
- 09/02/08      Amendment in response to non-final office action mailed 06/06/08 is filed, where **claims 1-23 were amended.**
- 10/27/08      Petition decision by the PCT Legal Affairs is mailed. Decision states: "Here, there is no clear instruction by the applicant that the annexes not be entered. Accordingly, the annexes should be entered. Thus, it is claims 1-23 included as an Annex to the NOTIFICATION OF TRANSMITTAL OF INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty) rather than claims 1-25 as published in the international application which are to be examined."
- 10/28/08      Final office action is mailed in response to amendment filed 9/02/08.
- 11/28/08      Petition for review by the Technology Center SPRE – requesting examiner to withdraw the final rejection of October 28, 2008 in light of the notification from the Legal Examiner of PCT Legal Affairs in the Office of Patent Cooperation Treaty Legal Administration that we received on October 30, 2008. The notification indicates that the Office of Patent Cooperation Treaty Legal Administration has made a determination that the *claims 1-23* included as an annex to the Form PCT/IPEA/416 are the claims that *should have been examined*.

### **REGULATION AND PROCEDURES**

#### **93.01(a) (2) [R-3]    Article 19 Amendment (Filed With the International Bureau)**

The claims of an international application may be amended under PCT Article 19 after issuance of the search report. The description and drawings may not be amended under PCT Article 19. The amendment is forwarded to the U.S. Designated Office by the International Bureau for inclusion in the U.S. national stage application. Article 19 amendments which were made in English will be entered by substituting each page of amendment for the corresponding English language page of claims of the international application. If the Article 19 amendments were made in a language other than English, applicant must provide an English translation for the U.S. national stage application. The Article 19 amendment(s) and the English translation of the amendment(s) must be received by the Office by the date of commencement of the national stage (see MPEP § 1893.01). Otherwise, the amendment(s) will be considered to be canceled, 35 U.S.C. 371(d). If such canceled amendments are desired, they must be offered under 37 CFR 1.121 as a preliminary amendment or a responsive amendment under 37 CFR 1.111. Applicants entering the national stage in the U.S. are *encouraged* to submit an amendment in accordance with 37 CFR 1.121 rather than an English translation of an Article 19 amendment.

**§ 1.121 Manner of making amendments in applications.**

c) Claims. Amendments to a claim must be made by rewriting *the entire claim* with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a *change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented*, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in *ascending numerical order*. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

**DECISION**

In view of the Office of Patent Cooperation Treaty Legal Administration determination dated 11/28/08 that the claims 1-23 included as an annex to the Form PCT/IPEA/416 are the claims that should have been examined, this petition is **GRANTED**.

Claims 1-23 to be examined filed on 3/18/08 have been amended by Applicant's reply filed 9/02/08. The final Office action mailed 10/28/08 is hereby **vacated** and a new Office action will be mailed in due course. The new office action will treat on the merits claims **1-23**, as amended on 9/02/08.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Tod Swann, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

/Beatriz Prieto/

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